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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,263	03/08/2004	Laurie A. Gallagher	H0005976	2374

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Honeywell International, Inc.
Patent Legal Services
101 Columbia Road
Morristown, NJ 07962

EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
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1751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/796,263

Applicant(s)

GALLAGHER ET AL.

Examiner

Brian P. Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 10, 2007 has been entered.

2. This Office action is in response to Applicant's amendment filed September 25, 2006. Applicant has amended claims 1, 3, 5, 6, 23, 36, and 42. Applicant has cancelled claim 2. Currently, claims 1 and 3-44 remain pending in the application.

3. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office actions, Paper Nos. 20060616 and 20061206.

4. The rejection of claim 42 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendments and remarks.

5. The rejection of claims 1 and 3-35 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitra et al, U.S. Patent No. 6,673,761, is maintained for the reasons of record.

6. The rejection of claims 1 and 3-35 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ouellette et al, U.S. 2004/0244132, is maintained for the reasons of record.

7. The rejection of claims 1-3, 5-7, 10-18 and 20-22 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bragulla, WO 2004/024857, is withdrawn in view of applicant's amendments and remarks.

8. The rejection of claims 36-44 under 35 U.S.C. 103(a) as being unpatentable over Mitra et al, U.S. Patent No. 6,673,761, is maintained for the reasons of record.

9. The rejection of claims 36-44 under 35 U.S.C. 103(a) as being unpatentable over Ouellette et al, U.S. 2004/0244132, is maintained for the reasons of record.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1 and 3-44 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shannon, US 2003/0168642.

Shannon, US 2003/0168642, discloses a dust repellant composition that comprises 0.1-10% by weight of an antistatic polymer, such as acrylates, polysiloxanes, fluorocarbons, and poly(acrylic acids) (see paragraphs 9 and 20-24), 0-5% by weight of a wetting agent, such as ethoxylated alcohols, sulfates, sulfosuccinates, and

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fluoropolymers (see paragraphs 10 and 25-31), 0.5-2% by weight of a film-forming polymer, such as polyacrylates (see paragraphs 11 and 32), and adjunct ingredients, such as foaming agents, pH buffers, biocides, corrosion inhibitors, such as acetic acid, and spreading agents (see paragraphs 35-36), as required in the instant claims. It is further taught by Shannon that the pH of the composition is about 9 (see paragraph 36), that water is used in the composition in an amount up to 99% (see paragraph 39), and that the composition is used for removing brake dust on tires and wheels (see paragraphs 2 and 42), per the requirements of the instant invention. Specifically, note Examples 1-5. Furthermore, the examiner asserts that "The fact remains that one of ordinary skill informed by the teachings of Shannon would not have had to choose judiciously from a genus of possible combinations to obtain the very subject matter to which appellant's composition per se claims are directed." *In re Sivaramakrishnan*, 213 USPQ 441 (CCPA 1982). Therefore, instant claims 1 and 3-44 are anticipated by Shannon, US 2003/0168642.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Response to Arguments

13. Applicant's arguments filed April 10, 2007 have been fully considered but they are not persuasive.

Applicant argues that Mitra et al, U.S. Patent No. 6,673,761, does not teach or suggest in general a brake dust barrier composition that contains 0.1-5% by weight of at least one film forming compound or fluorinated compound. However, the examiner respectfully disagrees. Specifically, Mitra et al clearly teaches the inclusion of polymers, such as polystyrenesulfonates (see col. 13, lines 15-45). Furthermore, the examiner asserts that the adjunct ingredients, such as polymers, taught by Mitra et al would meet the 0.1-5% by weight limitation recited in the instant claims, since it is known in the art that adjunct ingredients, such as polymers, are present in this amount. Applicant further argues that Mitra et al fails to provide a motivation to do what applicant has done, since Mitra et al is not directed toward a brake dust barrier composition. However, in response to applicant's argument that the references fail to teach compositions that are used in automotive applications to provide brake dust efficacy, the examiner asserts that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the examiner asserts that Mitra et al clearly teaches compositions that contain all of the required components in the amounts required in the instant claims, and therefore, meets the limitations of the instant claims. Furthermore, since Mitra et al includes all of the required components, the examiner asserts that the compositions would clearly be capable of providing brake dust efficacy. It is also noted by the examiner that the

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preamble of independent claim 1 is directed toward a cleaning formulation adapted to be applied to a surface, which is clearly taught by Mitra et al.

Applicant further argues that Ouellette et al, U.S. 2004/0244132, does not teach or suggest in general a cleaning formulation that contains about 50-99% by weight of water. However, the examiner respectfully disagrees. Specifically, Ouellette et al clearly discloses a composition that contains less than 50% by weight of water (see paragraph 156), which meets the limitation of "about 50% by weight" that is recited in the instant claims. Furthermore, as the word "about" recited in instant claims 1, 23 and 36 permits some tolerance (see *In re Ayers*, 69 USPQ 109 (CCPA 1946), and *In re Erickson*, 145 USPQ 207 (CCPA 1965)), the less than 50% by weight of water as taught by Ouellette et al may be considered to read on the instant claims, where "about 50% by weight of water" is claimed. Alternatively, if the range of prior art and the claimed range do not overlap, obviousness may still exist if the ranges are close enough that one would not expect a difference in properties (see *In re Woodruff*, 16 USPQ 2d 1934 (Fed. Cir. 1990); *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *In re Aller*, 105 USPQ 233, 255 (CCPA 1955)).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00AM-5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM

Brian P Mruk
April 17, 2007

Brian P. Mruk

Brian P Mruk
Primary Examiner
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